

REMARKS

Reconsideration and allowance of the claims are requested in view of the above amendments and the following remarks. Claims 1, 14 and 63 have been amended. Support for the claim amendments may be found in the specification and claims as originally filed. No new matter has been added.

Claims 7, 15-62 and 66-83 have been canceled without prejudice or disclaimer.

Upon entry of this amendment, claims 1-6, 8-14 and 63-65 are pending with claims 1, 14 and 63 being independent.

1. Rejections Under 35 U.S.C. §103

A. Rejections Based on Kaker et al., Capps and Venkatesh et al.

The Office Action rejects claims 1-6, 8-14 and 63-64 under 35 U.S.C. §103(a) as being unpatentable over Kaker et al. (2001/0037218) in view of Capps (5,666,502), and further in view of Venkatesh et al. (2003/0201320). Applicants respectfully traverse this rejection for at least the following reasons.

1) Office Action Fails to Consider Each and Every Element of Independent Claims

The present Office Action fails to consider how the cited references teach or suggest **each and every element** of independent claims 1, 14 and 63. Therefore, the Office Action fails to establish a prima facie case of obviousness in rejecting the independent claims (and their respective dependent claims).

The Examiner is respectfully directed to MPEP 2143.03, which states in part (emphasis added):

“All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

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However, in rejecting independent claims 1, 14 and 63 on pages 2-3 and 8 of Office Action, it is clear that the Office Action fails to consider several elements recited in the independent claims (as previously amended and unchanged by the present Amendment). For example, the Office Action fails to consider or provide any explanation for how the cited references teach or suggest at least the following elements of independent claims 1, 14 and 63, respectively (emphasis added):

1. A computer-implemented method, comprising:

...
in response to receiving the input, discovering, without further user interaction, a solution, the solution defining an availability of one or more actions for formatting data into one or more operable fields of an electronic form associated with the data file, wherein the availability of one or more actions is defined for each one of the one or more operable fields;

...
receiving input from the user to set the context of a selected operable field;

in response to the context set by the user, displaying to the user the availability of the one or more actions for formatting data in the selected operable field of the electronic form; and

after displaying the availability of the one or more actions, enabling the user to format data, based on the availability of the one or more actions, in the selected operable field of the electronic form.

14. One or more computer-readable storage media having stored thereon a plurality of computer-executable instructions performing steps comprising:

...
in response to receiving the input, discovering, without further user interaction, a solution, the solution defining an availability of one or more actions for formatting data in one or more operable fields of an electronic form associated with the data file, wherein the availability of one or more actions is defined for each one of the one or more operable fields;

...
receiving input from the user to set the context of a selected operable field;

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in response to the context set by the user, displaying to the user the availability of the one or more actions for formatting data in the selected operable field of the electronic form; and

after displaying the availability of the one or more actions, enabling the user to format data, based on the availability of the one or more actions, in the selected operable field of the electronic form.

63. An apparatus comprising:

...

means for discovering and deploying, in response to the selecting by the user and without further user interaction, a solution governing the data file, wherein the solution defines an availability of one or more actions for formatting data in ~~to~~ one or more operable fields of an electronic form associated with the data file, wherein the availability of one or more actions is defined for each one of the one or more operable fields;

...

means for receiving input from a user to set the context of a selected operable field;

means for displaying, in response to the context set by the user, the availability of the one or more actions to the user for formatting data in the selected operable field of the electronic form;

means for, after displaying the availability of the one or more actions, enabling the user to format data, based on the availability of the one or more actions, in the selected operable field of the electronic form; . . .

Therefore, applicants submit that the rejection of claims 1, 14 and 63 (and their respective dependent claims) under 35 U.S.C. §103(a) is improper. Applicants request a complete and prompt examination of each and every element recited in claims 1, 14 and 63.

2) Kaker et al. Does Not Disclose Discovering/Deploying a Solution Without Further User Interaction

In the previous Amendment filed on March 16, 2009, for the present application, applicants presented arguments regarding deficiencies in Kaker et al. (see pages 11-13 of

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Amendment filed March 16, 2009). However, the Examiner failed to respond to those arguments in the current Office Action. Therefore, the following discussion regarding deficiencies in Kaker et al. is presented below for the Examiner's careful review. Applicants request due consideration of, and a specific response to, the following arguments.

The Office Action on page 2 asserts that Kaker et al. discloses discovering/deploying, without user interaction, a solution (citing paragraph 125). Applicants disagree.

Kaker et al. discloses an online system for providing prescription assistance for indigent patients using programs provided by pharmaceutical manufacturers (see abstract). Kaker et al. states in paragraph 125 (emphasis added):

The Prescription Form Page 56 may be accessed by clicking the appropriate hyperlinked text statement on the Auto Fill Page 38. The request forwarded to the web server includes parameters specifying all of the information recorded in the Prescription Form on the Auto Fill Page 38. The server redirects the user to a PDF file that stores a copy of the manufacturer's Fill-In Form which is automatically filled with the appropriate data from the Prescription Form. A suitable software, such as the Adobe Acrobat, Adobe Systems, Inc., must be used by the user in order to view the form 58, edit the content that was autofilled and print it. The user can then complete the form (with signature, if required) and send it to the appropriate location.

Therefore, Kaker et al. explicitly requires that in order to view, edit and print the manufacturer's Fill-In Form, a user must first obtain and use suitable software (e.g., Adobe Acrobat). This is in stark contrast to receiving input from a user to merely open a data file, and then in response to receiving the input, discovering a solution or deploying the solution without further user interaction. As discussed in the present specification in paragraph 28 (emphasis added)

. . . If a user has opened the data file first online, or if the system has otherwise received the data file's solution, an electronic forms application can silently discover and deploy the data file's solution. The data file's solution declaratively defines aspects of the data file such as its elements, attributes, and values, as will be discussed below. The electronic forms application allows a user to simply select a data file to open and the electronic forms application will

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open the data file with a discovered and deployed solution. The user need not discover, select, or even be aware that the data file requires a solution for the data file to be edited. After selecting the data file to open, the user can then edit and access the data file in a way very similar to how it would act and appear had the user opened the data file while online.

As a result, Kaker et al. fails to teach or suggest at least the following elements of independent claims 1, 14 and 63, respectively (emphasis added):

1. A computer-implemented method, comprising:
a computer receiving input from a user to open a data file;
in response to receiving the input, discovering, without further user interaction, a solution, the solution defining an availability of one or more actions for formatting data in one or more operable fields of an electronic form associated with the data file, wherein the availability of one or more actions is defined for each one of the one or more operable fields;
deploying, without user interaction, the solution;
...
14. One or more computer-readable storage media having stored thereon a plurality of computer-executable instructions performing steps comprising:
receiving input from a user to open a data file;
in response to receiving the input, discovering, without further user interaction, a solution, the solution defining an availability of one or more actions for formatting data in one or more operable fields of an electronic form associated with the data file, wherein the availability of one or more actions is defined for each one of the one or more operable fields;
deploying, without user interaction, the solution;
...
63. An apparatus comprising:
...
means for selecting the data file by a user using the user interface;
means for discovering and deploying, in response to the selecting by the user and without further user interaction, a

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solution governing the data file, wherein the solution defines an availability of one or more actions for formatting data into one or more operable fields of an electronic form associated with the data file, wherein the availability of one or more actions is defined for each one of the one or more operable fields;

...

Capps and Venkatesh et al. also fail to teach or suggest, and are not cited by the Office Action as teaching or suggesting, the features discussed above that are missing from Kaker et al.

3) Kaker et al., Capps and Venkatesh et al. Fail to Teach or Suggest All of the Elements of the Independent Claims

Therefore, since Kaker et al., Capps and Venkatesh et al., alone or in combination, fail to disclose or suggest all of the elements of independent claims 1, 14 and 63, these claims are allowable.

Claims 2-6 and 8-13 depend from claim 1. Claim 64 depends from claim 63. As discussed above, claims 1 and 63 are allowable. For at least this reason, and the additional features recited therein, claims 2-6, 8-13 and 64 are also allowable.

For at least the reasons above, reconsideration and withdrawal of the rejection of claims 1-6, 8-14 and 63-64 under 35 U.S.C. §103(a) are respectfully requested.

B. Rejections Based on Kaker et al., Capps, Venkatesh et al., and Turpin

The Office Action rejects claim 65 under 35 U.S.C. §103(a) as being unpatentable over Kaker et al. in view of Capps and Venkatesh et al., and further in view of Turpin (5,640,501). Applicants respectfully traverse this rejection for at least the following reasons.

As discussed above, Kaker et al., Capps and Venkatesh et al., alone or in combination, fail to disclose or suggest all of the elements of independent claim 63. Turpin fails to cure this defect.

Turpin is cited by the Office Action primarily for its teaching of various editing and

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formatting operations (citing Fig. 6; col. 16, line 46 – col. 17, line 46). However, Turpin fails to teach or suggest at least the elements discussed above with respect to claim 63.

Therefore, since Kaker et al., Capps, Venkatesh et al., and Turpin, alone or in combination, fail to disclose or suggest all of the elements of independent claim 63, this claim is allowable.

Claim 65 depends from claim 63. As discussed above, claim 63 is allowable. For at least this reason, and the additional features recited therein, claim 65 is also allowable.

For at least the reasons above, reconsideration and withdrawal of the rejection of claim 65 under 35 U.S.C. §103(a) are respectfully requested.

2. Conclusion

Accordingly, in view of the above amendment and remarks it is submitted that the claims are patentably distinct over the cited art and that all the rejections to the claims have been overcome. Reconsideration and reexamination of the present application is requested. Based on the foregoing, applicants respectfully request that the pending claims be allowed, and that a timely Notice of Allowance be issued in this case. If the Examiner believes, after this amendment, that the application is not in condition for allowance, the Examiner is requested to call the applicants' attorney at the telephone number listed below.

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If this response is not considered timely filed and if a request for an extension of time is otherwise absent, applicants hereby request any necessary extension of time. If there is a fee occasioned by this response, including an extension fee that is not covered by an enclosed check please charge any deficiency to Deposit Account No. 50-0463.

Respectfully submitted,
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/Rimma N. Oks/
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